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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,997	05/26/2006	Piero Andreas Madar	PU030323	7261

24498   7590   12/20/2010
Robert D. Shedd, Patent Operations
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EXAMINER
VAUGHAN, MICHAEL R

ART UNIT	PAPER NUMBER
2431	

MAIL DATE	DELIVERY MODE
12/20/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/580,997	MADAR ET AL.
	Examiner	**Art Unit**	
	MICHAEL R. VAUGHAN	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 December 2010</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20101216

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

12/07/10 has been entered.

Claims 1, 4, 5, 7, 8, 11, 12, 15, 16, and 18-20 are amended. Thus claims 1-20

are pending.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent Publication 2003-132624 to **Tsurui** in view of USP Application Publication 2002/0146238 to **Sugahara** and USP 6,469,718 to **Setogawa** et al., hereinafter Setogawa.

As per claims 1 and 8, Tsurui teaches a method and a digital recording and playback apparatus comprising:

enabling a user to record digital signals onto a digital storage medium in a first program chain for password protection said first program chain being a single program chain according to DVD specifications (0030-0031);

receiving a password from said user for said selected recording title (0033);

storing said password for said selected recording title on said digital storage medium (0051);

storing a password menu screen for said selected recording title on said digital storage medium (0033-36); and

requiring said password to be input before playing back said selected recording title (0030). Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post command (0042). Therefore Tsurui is silent in disclosing storing the selected recording

title, the password menu, and the password in a single PGC. Tsurui teaches several program chains linking to each other in order to carry out the password entry for the selected recording title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password, address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the selected title (program number), relative address (pointer to the video content), and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC, with its cells, could store the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with the title in a single program chain. This just leaves the location of the password menu. Prior art Setogawa further teaches that using a single program chain is more efficient than a plurality of program chains because access time is decreased with the PGC data

including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already

teaches the password is stored with the menu (0037) and Sugahara teaches the

password can be stored with the title in a single program chain. Thus incorporating the

fact that is it more efficient to store everything in one program chain, one of ordinary skill

in the art could have tried storing the title, password, and menu in one program chain.

As long as doing so does not conflict the DVD specification, there are no unpredictable

results. All three references operate within the DVD specification. After reviewing the

claims and the prior art, Examiner finds the notion of using one or more program chains

moot. One of ordinary skill in the art could have used or tried any number of program

chains to implement a password protected DVD as a matter of common sense. Tsurui

clearly shows it is possible to do so while adhering to the DVD specification. More over,

because a program chain is simply made up of any number of cells, the very nature of a

chain with links obviously lends itself to the idea that one could simply make a longer

chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill

in the art could not have placed the title, password, and menu in one program chain. As

such, the claim is obvious because one of ordinary skill in the art has good reason to

pursue the known options within his or her technical grasp. Since placing the title,

menu, and password leads to anticipated success (less delay while adhering to the

DVD specification), it is likely the product not of innovation but of ordinary skill and

common sense.

As per claim 16, Tsurui teaches a digital storage medium, comprising:

a plurality of data fields [DVD standard] (0027); and

wherein said data fields comprise a first program chain [PCG#10] for storing a
selected recording title the program chain being according to DVD specification (0030).

Tsurui teaches the password is stored in a PGC which includes the program for
driving the password input menu (0037). Tsurui teaches a separate single PGC for
playing back the selected title [collation program utilized to play back the picture/audio
data; 0030] which is invoked by PGC which calls the video in its post command (0042).
Therefore Tsurui is silent in disclosing storing the selected recording title, the password
menu, and the password in a single PGC. Tsurui teaches several program chains
linking to each other in order to carry out the password entry for the selected recording
title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a
similar system in which a PGC which calls list information includes both the password,
address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara
describes the nature of what PGC do, namely they prescribe the order by which content
is displayed. Sugahara teaches that list information blocks perform the same function
(0018). The list information even has cells which PCG also have. Clearly list
information and PGC are equivalent. What is unique in Sugahara is that both the
selected title (program number), relative address (pointer to the video content), and the
password for that number are stored in the same cell of a single list information (PGC)
(0089). Sugahara does this to protect the individual content with a password to prevent
others from viewing the content. This is the same reasoning for the passwords of

Tsurui. Only this method yields a more granular means of control over the content.

One of ordinary skill could have stored the password in the same single PGC as the title

without parting from the invention's purpose.   A single PGC, with its cells, could store

the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with

the title in a single program chain. This just leaves the location of the password menu.

Prior art Setogawa further teaches that using a single program chain is more efficient

than a plurality of program chains because access time is decreased with the PGC data

including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already

teaches the password is stored with the menu (0037) and Sugahara teaches the

password can be stored with the title in a single program chain. Thus incorporating the

fact that is it more efficient to store everything in one program chain, one of ordinary skill

in the art could have tried storing the title, password, and menu in one program chain.

As long as doing so does not conflict the DVD specification, there are no unpredictable

results. All three references operate within the DVD specification. After reviewing the

claims and the prior art, Examiner finds the notion of using one or more program chains

moot. One of ordinary skill in the art could have used or tried any number of program

chains to implement a password protected DVD as a matter of common sense. Tsurui

clearly shows it is possible to do so while adhering to the DVD specification. More over,

because a program chain is simply made up of any number of cells, the very nature of a

chain with links obviously lends itself to the idea that one could simply make a longer

chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill

in the art could not have placed the title, password, and menu in one program chain. As such, the claim is obvious because one of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. Since placing the title, menu, and password leads to anticipated success (less delay while adhering to the DVD specification), it is likely the product not of innovation but of ordinary skill and common sense.

As per claims 2, 9, and 17, Tsurui teaches the digital storage medium is a DVD (0030).

As per claims 3 and 10, Tsurui teaches the step of storing at least one command on said digital storage medium in said first program chain (0071).

As per claims 4 and 11, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040).

As per claims 5 and 7, Tsurui teaches at least one command [commands into collation PGC to check for and guide password entry] is created and stored in response to receiving said password from said user (0035).

As per claim 6, Tsurui teaches wherein said at least one command includes a
PRE command according to DVD specification (0041).

As per claims 12, 15, and 19, the combination of Tsuria and Sugahara essentially
moves the password and the selected title into a single PGC. Thus, Tsurui teaches
creating at least one command [commands into collation PGC to check for and guide
password entry] and causes said at least one command to be stored on said digital
storage medium in said first program chain in response to an input from said user
defining said password (0035). The claim is obvious because this is a predictable result
from Tsuria and Sugahara as combined in the rejection of claim 1.

As per claim 13, Tsurui teaches at least one command includes a plurality of
commands [chain leads to multiple other commands with there respective pre/post
commands; 0042-0046].

As per claim 14, Tsurui a plurality of commands comprise PRE commands
according to DVD specifications [chain leads to multiple other commands with there
respective pre/post commands; 0042-0046].

As per claim 18, Tsurui teaches said first program chain also stores at least one
command [PGC#10; 0046 and Figure 5b].

As per claim 20, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040) and input of said user-assigned password is required before playing back said selected recording title (0051).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431